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09/636,424	08/10/2000	Peter Beran	2883/0G357	6052

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Darby & Darby PC
805 Third Avenue
New York, NY 10022

EXAMINER

SCHLAIFER, JONATHAN D

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 01/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/636,424

Applicant(s)

BERAN ET AL.

Examiner

Jonathan D. Schlaifer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 August 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2 . 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to application 09/636,424 filed on 08/10/2000, with prior art filed on 8/10/2000.
2. Claims 1-18 are pending in the case. Claims 1 and 15 are independent claims.

Drawings

3. New corrected drawings are required in this application because Fig. 1, 2, and 3 A-C are unclearly drawn, illegible, and indistinct. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Objections

4. Claim 1 objected to because of the following informalities: In line 8, "corresponding the" should be "corresponding to the". Appropriate correction is required.
5. Claim 14 objected to because of the following informalities: In line 2, "A DVD-ROM" should be "a DVD-ROM". Appropriate correction is required.
- 6.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 1, 3, 9-11 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell et al. (USPN Re. 30,666—filing date 9/25/1975), hereinafter Mitchell, further in view of Ball et al. (USPN 6,240,391 B1—filing date 5/25/1999), hereinafter Ball**
8. **Regarding independent claim 1**, Mitchell discloses a method for synchronizing audio data to text data from a source (Mitchell's invention, as disclosed in the Abstract, is a printed text with synchronized audio inclusions). Mitchell further discloses segregating a source text data of a given format into a plurality of text sections (because the text is in the form of a book, it is divided into pages as is clear from Fig. 1-3). Finally, since the audio recordings are individually cross-referenced to the text, (as described in the Abstract), presumably the recordings are produced by recording in any order audio data portions each corresponding to a text section. Mitchell fails to disclose converting each recorded audio portion into an audio data file, assembling the audio data files in a sequence corresponding to the given format of the source text data, and generating for said assembled data files a playback control file indicating points of navigation of the source text data. However, Ball discloses in col. 25, lines 27-39 that recorded audio may be converted into an audio data file to facilitate transmission over a network, and since the audio files are attached to network messages, they must be assembled into a sequence in order to be transmitted successfully. It would have been obvious to one of ordinary skill in the art at the time of the invention to convert the recorded audio into files and to assemble them into a sequence in order to facilitate their transmission over a network. Furthermore, in col. 25, lines 1-26, Ball discloses generating for said assembled data file

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a playback control file indicating points of navigation of the source text data because it allows the user to manipulate the audio. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate a playback control file because it would allow the user to manipulate the audio.

9. **Regarding dependent claim 3**, Mitchell clearly discloses that the text is divided into sections by pages, as show by Figures 1-3.
10. **Regarding dependent claim 9**, Mitchell discloses in the Abstract that the audio portions of the audio-visual information system are recorded in discrete portions as adjuncts to the text, hence implying that the audio portions are recorded by one or more narrators in any sequence and at any time or times.
11. **Regarding dependent claim 10**, it was notoriously well known in the art at the time of the invention that one could use at least two narrators in order to provide different narrative voices and that computers are used to provide an easy way of recording information. It would have been obvious to one of ordinary skill in the art at the time of the invention to use at least two narrators in order to provide different narrative voices and have computers provide an easy way of recording information.
12. **Regarding dependent claim 11**, it was notoriously well known in the art at the time of the invention that terminals whose operation must be coordinated are coordinated by being connected by at least one of a local area network, a wide area network, an intranet, and an Internet connection because these connections facilitate collaboration. It would have been obvious to one of ordinary skill in the art at the time of the invention to

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connect the terminals with a local area network, a wide area network, an intranet, and an Internet connection because these connections facilitate collaboration.

13. **Regarding independent claim 15**, it is an apparatus that performs the method of claim 1, and ^{is}~~may~~ be rejected under similar rationale.

14. **Regarding dependent claim 16**, it is an apparatus that performs the method of claim 2, and ^{is}~~may~~ be rejected under similar rationale.

15. **Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell further in view of Ball further in view of Barbara et al. (USPN 5,926,789—filing date 12/19/1996), hereinafter Barbara**

16. **Regarding dependent claim 2**, Mitchell and Ball fail to disclose that said playback control file contains links to corresponding point of navigation of said audio data files. However, Barbara discloses in col. 1, lines 60-67 that audio items on pages are indexed via links in order to aid in their retrieval. It would have been obvious to one of ordinary skill in the art at the time of the invention to have navigational links to the audio files to aid in retrieving the audio data.

17. **Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell further in view of Ball further in view of Lowe et al. (USPN 5,695,401—filing date 12/2/1994), hereinafter Lowe**

18. **Regarding dependent claim 4**, Mitchell and Ball fail to disclose a method wherein a narrator reads a selected text section to form an audio portion and produces a mark of the beginning and end of the text section recorded as an audio portion to mark the points for converting to an audio data file. However, Lowe, in col. 8, lines 25-35, discloses the use

of marking start and end points of narration in order to facilitate the procedure by which narration is added by clarifying when it should start and stop. It would have been obvious to one of ordinary skill in the art at the time of the invention to mark the beginning and end of narration in order to clarify when it should start and stop.

19. Claims 5, 13-14, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell further in view of Ball further in view of Reinold et al. (USPN 6,335,768 B1—filing date 5/4/1998), hereinafter Reinold

20. Regarding dependent claim 5, Mitchell and Ball fail to disclose a method further comprising the steps of placing the assembled audio data files and playback control file on a medium for audio playback of said audio data files and display of said playback control file. However, Reinold, in col. 4, lines 45-60 and col. 5, lines 5-20 discloses the encoding of the audio into formats such as RealAudio and WAV, for which there are standard players available, onto a storage medium, such as a CD-ROM or a DVD, in order to provide a hardware basis for interacting with the audio. It would have been obvious to one of ordinary skill in the art at the time of the invention to transfer the audio data files and the player on a CD or DVD as in Reinold's invention in order to provide a hardware basis for interacting with the audio.

21. Regarding dependent claim 13, Mitchell and Ball fail to disclose a method further comprising storing the playback control data, the audio and the text data on a portable computer-readable medium. However, Reinold, in col. 4, lines 45-60 and col. 5, lines 5-20 discloses the encoding of the audio into formats such as RealAudio and WAV, for which there are standard players available, onto a portable storage medium, such as a

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CD-ROM or a DVD, in order to provide a hardware basis for interacting with the audio.

It would have been obvious to one of ordinary skill in the art at the time of the invention to transfer the audio data files and the player on a CD or DVD as in Reinold's invention in order to provide a hardware basis for interacting with the audio.

22. **Regarding dependent claim 14**, Mitchell and Ball fail to disclose a method wherein the portable computer readable medium comprises at least one of a CD-ROM, a DVD-ROM, a ZIP disk, and a floppy disk. However, Reinold, in col. 4, lines 45-60 and col. 5, lines 5-20 discloses the encoding of the audio into formats such as RealAudio and WAV, for which there are standard players available, onto a portable storage medium, such as a CD-ROM or a DVD, in order to provide a hardware basis for interacting with the audio. It would have been obvious to one of ordinary skill in the art at the time of the invention to transfer the audio data files and the player on a CD or DVD as in Reinold's invention in order to provide a hardware basis for interacting with the audio.

23. **Regarding dependent claim 17**, it is an apparatus for playing back the medium encoded by the method of claim 5 and hence the rejection of this claim is the logical extension of that claim.

24. **Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell further in view of Ball, further in view of Reinold, further in view of Barbara**

25. **Regarding dependent claim 6**, Mitchell and Ball and Reinold fail to disclose that said playback control file contains links to corresponding point of navigation of said audio data files. However, Barbara discloses in col. 1, lines 60-67 that audio items on pages are indexed via links in order to aid in their retrieval. It would have been obvious to one of

ordinary skill in the art at the time of the invention to have navigational links to the audio files to aid in retrieving the audio data.

26. Claims 7-8 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell further in view of Ball, further in view of Reinold, further in view of Holm (USPN 5,850,629, see IDS—filing date 9/9/1996)

27. Regarding dependent claim 7, Mitchell, Ball, and Reinold fail to disclose a user selecting a text section to be played back by selecting the section from the display, and audio reproduction of the selected text section. However, Holm, in the Abstract, discloses text-to-speech production from selected sections of documents in a display in order to provide auditory versions of visual material. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Holm's text-to-speech from selection features into Mitchell, Ball, and Reinhold's inventions in order to provide auditory versions of visual material.

28. Regarding dependent claim 8, Mitchell, Ball, and Reinold fail to disclose that the source data text is played on the medium and the text is displayed upon selection from the playback control file. However, it is inherent to Holm that the source data text be placed upon the medium because there must be a physical source of the text, which is clearly shown as being displayed in Figure 1 to provide the user with an interactive model of the text that is spoken. It would have been obvious to one of ordinary skill in the art at the time of the invention to store the text on the medium and display the text because there must be a physical basis of storage for the text for it to be displayed as in Holm, which is done to provide the user with an interactive model of the text that is spoken.

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29. **Regarding dependent claim 18**, it is an apparatus for playing back the medium encoded by the method of claim 8 and hence the rejection of this claim is the logical extension of that claim.
30. **Claims 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell further in view of Ball, further in view of Puranik et al. (USPN 6,003,090—filing date 4/23/1997), hereinafter Puranik**
31. **Regarding dependent claim 12**, Mitchell and Ball fail to disclose that the text data is stored in at least one of an HTML format and a XML format. However, Puranik cites several advantages of using HTML in col. 8, lines 15-25, including hypertext links, HTTP, and event information. It would have been obvious to one of ordinary skill in the art at the time of the invention to use HTML in order to take advantage of hypertext links, HTTP, and event information.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

USPN 5,465,240 (filing date 1/5/1993)—Mankovitz

USPN 6,260,011 (filing date 1/20/2000)—Heckerman et al.

USPN 5,832,171 (filing date 6/5/1996)—Heist

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan D. Schlaifer whose telephone number is 703-305-9777. The examiner can normally be reached on 8:30-5:00, M-F.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 703-308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

JS


JOSEPH H. FEILD
PRIMARY EXAMINER